

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Shin Iima, et al.
Serial No. : 09/920,883
For : COMMUNICATION APPARATUS,
COMMUNICATION SYSTEM, AND METHOD
OF SAME
Filed : August 02, 2001
Examiner : Chang, Shirley
Art Unit : 2614
Confirmation No. : 5191

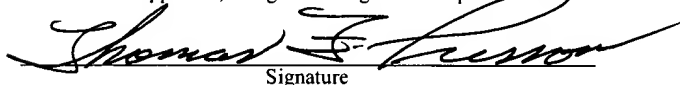
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Thomas F. Presson, Reg. No. 41,442

Name of Applicant, Assignee or Registered Representative


Signature

April 21, 2006

Date of Signature

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants request review of the Final Rejection dated December 29, 2005 in the above-captioned application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. Please consider the reasons stated herein.

REASONS FOR REQUEST

I. STATUS OF THE CLAIMS AND FORMAL MATTERS

Claims 1-14 are pending. Claims 1, 4, 10 and 11 are independent. It is submitted that these claims, as originally presented, were in full compliance with the requirements of 35 U.S.C. §112.

II. REJECTIONS UNDER 35 U.S.C. §103(a)

Claims 1-14 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent No. 6,698,020 to Zigmond, et al. (hereinafter, merely “Zigmond”) in view of U.S. Pub. No.: 2002/0010927 to Kim (hereinafter, merely “Kim”).

Claim 1 recites, *inter alia*:

“A communication apparatus comprising:...

an output signal generating means for generating an output signal by using said separated program signal and additional signal upon determination to output in accordance with said additional signal and for generating the output signal by using said separated program signal where it is determined not to output in accordance with said additional signal;

wherein the additional signal is displayed simultaneously with the program signal inside or outside a window of a program corresponding to the program signal;
(Emphasis Added)

Applicants note that Kim was filed on January 12, 2001, and claims priority to U.S. Provisional Application 60/176,121 filed on January 14, 2000.

The present application has a priority date of August 3, 2000. Thus, Applicants are entitled to an effective filing date of August 3, 2000, which is prior to Kim’s filing date of January 12, 2001.

Upon review of U.S. Provisional Application 60/176,121, Applicants submit that there is no disclosure that would support the rejection. Indeed, the portion of Kim relied upon by the Office Action, paragraph [0076], is not part of U.S. Provisional Application 60/176,121.

Specifically, Applicants submit there is no teaching or suggestion in the provisional application that the additional signal is displayed simultaneously with the program signal inside or outside a window of a program corresponding to the program signal, as recited in independent claim 1.

The Office Action relies on the first paragraph on page 3 and the first paragraph on page 4 to teach the above cited limitation of independent claim 1. The first paragraph on page 3 merely discloses “that the Digital TV Service Operator (SO) can present commercial banner advertisement on their video presentation devices.” The first paragraph on page 4 merely discloses “the user’s Free Digital TV receiver receives and demodulates the signal of the channel that the user tuned, decodes and delivers the regular TV programs to the user’s presentation device, and also decodes, renders, and presents the Banner Information to the user’s video presentation device.” The cited portions of the provisional application do not teach or suggest that the additional signal is displayed simultaneously with the program signal inside or outside a window of a program corresponding to the program signal.

Therefore, independent claim 1 is believed to be patentable.

For reasons similar to, or somewhat similar to, those described above with regard to independent claim 1, independent claims 4, 10 and 11 are also believed to be patentable.

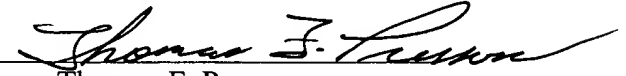
The other claims in this application are each dependent on an independent claim discussed above, and are therefore believed patentable for at least the same reasons. Since each

dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

Please charge any additional fees that may be needed, and credit any overpayment, to our Deposit Account No. 50-0320.

Respectfully submitted,

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